

REMARKS

Claims 1-211 are indicated as pending, however Applicant notes that claims 171-176 in fact are not pending because they never existed as a result of an inadvertent slip in numbering. Claims 160-163, 167, 177, 178, 181, 183, 184, 188, 191-193, 196, 198, 199, 203, 207, 208, and 211 are withdrawn from consideration (despite traversal of requirement by Applicant). Claims 1-159, 164-166, 168-170, 179, 180, 182, 184, 185-187, 189, 190, 194, 195, 197, 200-202, 204-206, 209, and 210 stand rejected. Applicant and the undersigned appreciates the Examiner's courtesy extended during the personal interview with the undersigned on April 23rd, 2008, at 11: a.m., and a subsequent telephone interview on May 2nd, 2008. In view of the above amendments to the claims and the arguments presented below, Applicant respectfully requests the Examiner to reconsider all the outstanding rejections and to withdraw them.

35 U.S.C. § 103 Rejections

In paragraph 2 of the office action, the Examiner has variously rejected claims 1-159, 164-166, 168-170, 179, 180, 182, 185-187, 189-190, 194-195, 197, 200-202, 204-206, and 209-210 under 35 U.S.C. §103(a) as unpatentable over De Lapa et al. (U.S. Patent No. 5,822,735). With respect to De Lapa et al., the Examiner indicates (set forth in italics) the following rationale for rejecting the pending claims:

De Lapa teaches a method of automatically preparing a communication pertaining to a product for an entity (Abstract). (1) Automatically determining whether to offer a product to said entity (figure 6); (2) if it is determined to offer a product to said entity, then using decision information to automatically determine variable information, the variable information in the communication for said entity (see Figures 2 and 6); (3) and automatically generating the communication, the communication including an offering to said entity for a product, the communication having communication format, wherein said communication format comprises at least one portion that accommodates the variable information, the generating step including incorporating the variable information into said at least one portion of the communication, wherein the variable information is related to said offering, and wherein the content of said offering in said communication includes variable information such that said offering comprises said variable information in

said offering at least partially identifies the product being offered to said entity (see Figure 2).

*De Lapa teaches that said variable information may vary among persons being offered said product or said service such that offers of said product to said persons may vary from person to person (i.e. **assigning different coupon values to non-customer versus regular customers in order to further induce the customer to the retail store**)(in De Lapa, col. 5, lines 14-17 and col. 20, lines 9-12).*

De Lapa, col. 5, lines 14-17 and col. 20, lines 9-12

This may be accomplished, for example, by assigning higher coupon values to non-customers of the participating retailer than to regular established customers, in order to further induce the consumer to the retailer's store.

DeLapa teaches the steps being performed using data processing devices and within an automated process (i.e. the steps of determining and generating are performed via a computerized system)(see Figure 4).

With respect to the newly added feature of the product/service set includes at least one or more product or services that is at least considered for offering to each entity in said entity set who is being considered for an offer (i.e. the coupon can be assigned to more than one prior members who is eligible to receive the coupon)(col. 14, lines 33-40)

De Lapa, col. 14, lines 33-40

The routine is initiated (110) by selecting (112) the first record of a member. The Current Coupon Data Structure is accessed to select (114) the first coupon authorized for that mailing. It is then determined at (116) whether that coupon has been exhausted as a result of assignment to prior members. Because this is the first member, it will be determined at 116 that the coupon is not exhausted. It is then determined at (118) whether this coupon is mandatory.

De Lapa does not specifically teach that the offer is for a financial product or financial service. Official notice is taken that it is old and well known to offer financial products or financial services to customers. For example, bank customers are often offer additional services such as car loans, vacation loans, mortgages loans in order for the banks to provide additional services or products that might be needed by the customers.

With respect to claims 2-11, 65-73 De Lapa further teaches storing said data in one or more databases and collecting additional data from one or more sources, and updating said one or more databases with said additional data accessible via modem (col. col. 7, lines 61-67).

De Lapa, col. col. 7, lines 61-67

Captured data files in data base 176 are uploaded (78) to data base 92 and, in turn, uploaded (80) via modem 64a and 64b in order to update (82) master data base 31. In-store system 69 may, optionally, include a retailer host computer 89 for the management of the data processing functions of the store and other functions not related to focused coupon system 15.

Claims 12-52, 74-115, 132-138, 142, 170, 180 further recite selecting the format for the communication and said selected delivering medium. Official notice is taken that it is well known to select different mediums in which to deliver information to users. For example, some users prefer e-mail to regular mail and this is taken into account in order to select the medium in which to deliver information.

With respect to claims 59-63, 122-126, 139-140, 205-206 the claims further recite that the services relate to mortgage loan, insurance. Official notice is taken that mortgages loans and insurance related products are well known products or services offer to clients in order to meet client's needs. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the services or products to be related to mortgage loans and insurance in order to obtain the above mentioned advantages.

With respect to claim 141, De Lapa further teaches providing said communication and reply means to said entity electronically (Figure 5).

With respect to claim 149, 152 De Lapa further teaches selecting a first and second delivering medium that will be used to deliver subsequent communication pertaining to said offer (Figures 1 and 5).

Criteria Governing 35 U.S.C. Section 103 Rejections

For rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 The establishment of a *prima facie* case of obviousness requires that the claimed combination cannot **change the principle of operation of the primary reference or render the reference inoperable for its intended purpose.** MPEP § 2143.03.

The Supreme Court set the standard for evaluating obviousness in its recent decision (*KSR International Co. v. Teleflex Inc. et al.* (550 U.S. ____ 2007)) to be “expansive and flexible” and “functional.” However, the standard is **not** controlling, rather, the various noted

factors only “can” or “might” be indicative of obviousness based on the facts. The Supreme Court in KSR enunciated the following principles:

“[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, Section 103 likely bars it patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill....[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)). The Supreme Court while recognizing the need “to guard against slipping into the use of hindsight,” acknowledged the following principles:

[r]ejection on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.

Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993). The Supreme Court in KSR stated that:

a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently, known in the prior art.

An examiner may often find every element of a claimed invention in the prior art. “Virtually all [inventions] are combinations of old elements.” *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983), cert. denied, 464 U.S. 1043 (1984); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. The Supreme Court in KSR has also stated that:

[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the market place.

Further, the Supreme Court states that:

The Court relied upon the corollary principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.

When considering the question of obviousness, further evidence of nonobviousness may also be considered, such as, for example, commercial success of the subject matter. *Perkin-Elmer Corp. v. Computervision Corp.*, (732 F2d 888, 893).

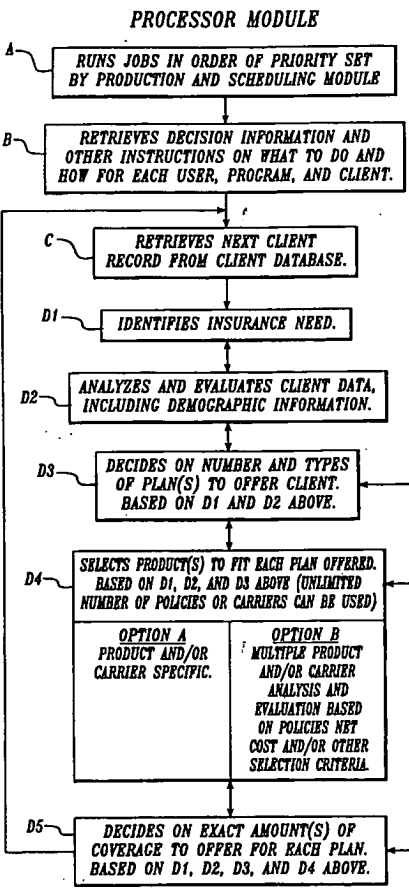
Discussion of the Differences Between Applicant's Claims and De Lapa

Applicant respectfully submits that his inventive method and system is completely distinct from De Lapa in its intended purpose and operation. At least three reasons are indicated below. Independent claims 1, 64, 159, 182 and 197 are amended to further emphasize these

distinctions. For the Examiner's convenience, a summary table is provided below with amended claims 1 and 64, the support in the present specification for the claimed recitations and the distinctions from De Lapa. Claims 159 and 182 are amended to recite similar distinctions. Claim 197 recites specific details that are clearly not present in De Lapa.

Summary Table

Claims 1 & 64	Specification Support	Distinctions from De Lapa
<p>A <u>computer-</u> <u>implemented</u> method of automatically preparing an offering of one or more financial products or financial services or both for a specific entity <u>entities, with</u> <u>use of a processor and one</u> <u>or more associated</u> <u>databases</u>, the method comprising the steps of:</p>		<p><u>All sections in bold not taught in De Lapa – text from De Lapa indicated below teaches away from the claims (e.g. see claims 1 and 64).</u></p> <p>For reasons that will be set forth in more detail below, the coupons 48 are individually selected for each consumer in order to improve the redemption rate for the particular coupons. <i>Col. 9, lines 34-37 (emphasis added)</i></p> <p>There will be one record for each coupon sent to each member. <i>Col. 11, lines 63-64 (emphasis added).</i></p> <p>If it 25 is determined at 136 that the criterion set forth is satisfied, then this coupon is assigned to this member at 120. If not, the loop repeats until all relationship records for this coupon are determined at 138 to be exhausted. Control then passes to 126 where the next authorized coupon is selected. <i>Col. 15, lines 15-17 (emphasis added).</i></p> <p>The cyclic coupon selection mailing routine selects coupons by consumer rather than visa versa. In order to determine whether an optional coupon is assigned to a particular member, answers provided</p>

Claims 1 & 64	Specification Support	Distinctions from De Lapa
		<p>by the member to the survey are examined for appropriate relationships. Thus, answers are 50 examined in order to determine whether a coupon is appropriate rather than attempting to locate coupons which correlate with particular answers rendered by the member. <i>Col. 15, lines 46-53 (emphasis added).</i></p>
<p>(1) <u>using the processor to consider</u> considering client data on specific entities and <u>determine</u> determining whether to offer a financial product or a financial service or both to the specific entity <u>entities</u> (e.g., Fig. 8 and col. 18, lines 32-49 of related issued patent – application text indicated in the adjacent column),</p>	<p><u>Fig. 8</u></p>  <p><u>Page 26, line 29 to page 27, line 7</u> In step D3 of the processor module flow depicted in FIG. 8, the module decides on the number and types of plans to be proposed to the client, which represents financial product variable information. This</p>	

Claims 1 & 64	Specification Support	Distinctions from De Lapa
	decision is based upon the insurance needs of the clients as identified in the decision information, on the client information in the client record, and possibly on other information such as demographic information, geo-coding information, etc. This step involves making an informed intelligent decision regarding the possible solution or solutions to the product or protection needs of the customer. Factors which may be considered by the module in this selection process may include the client demographic information (e.g. age, gender, tobacco usage, and occupation) mortgage information, financial information such as income, marital information, existing policy information, family-related information, and other factors selected by the system user and incorporated into the processor module decision making criteria.	
(2) if it is determined the processor makes a determination to offer said financial product or said financial service or both to said entity, then <u>the processor uses client-specific decision information to automatically determining selects parts of</u> variable	<u>Page 24, lines 8-12</u> According to the method, the decision information is used or processed to automatically select variable information. In the preferred method, the decision information is used to select a subset of the variable information for inclusion in the variable portion or portions of the client communication corresponding to the variable portion or portions of the client communication format. <u>Page 24, lines 16-18</u> The subset of variable information for a given client then may be used	

Claims 1 & 64	Specification Support	Distinctions from De Lapa
<p><u>information from at least two different databases with client data and financial product data to determine the variable information specific to each specific entity (e.g., col. 16, lines 44-50 and col. 18, lines 26-31 of related issued patent – application text indicated in the adjacent column) and selects the parts of the variable information determined for inclusion in a communication formulated to express the offering for said specific entity (e.g., col. 16, lines 55-58 and col. 22, lines 11-14 of related issued patent – application text indicated in the adjacent column); and</u></p>	<p>in the subsequently-prepared communication for that client to individualize or personalize the communication.</p> <p><u>Page 25, lines 8-12</u> The processor module flow at block C retrieves the information, in this case a client record (client information), which is to be used with the decision information in selecting the variable information. By operating upon the decision information, such as database query commands based upon the client database fields, the system processes the client information and uses it to select the variable information.</p> <p><u>Page 26, lines 25-28</u> Variable information may be selected using client information, i.e., the decision information may include using client information to select the variable information for inclusion in the client communication. This is generally true regardless of the nature or content of the information actually selected as the variable information.</p> <p><u>Page 27, lines 8-10</u> The processor module in conjunction with the decision information selects the variable information, in this example the financial products, which satisfy the decision making criteria being employed in the module.</p> <p><u>Page 32, lines 10-12</u> The subset or subsets of the variable information selected for a</p>	

Claims 1 & 64	Specification Support	Distinctions from De Lapa
	<p>given client is adapted to be inserted into or provided as an integral part of the corresponding variable portion or portions of the client communication for that client.</p>	
<p>(3) <u>using an output module associated with the processing system and configured to use at least one automated process to automatically compose the variable information comprising the parts determined to create and generate</u> generating, using at least one automated process on at least one data processing device, the communication for each said specific entity with such that at least one portion within the communication that accommodates the variable information, (e.g., <i>col. 22, lines 36-50 of related issued patent – application text indicated in the adjacent column</i>) wherein said variable information for each specific entity comprises at</p>	<p><u>Page 32, lines 10-12</u> The subset or subsets of the variable information selected for a given client is adapted to be inserted into or provided as an integral part of the corresponding variable portion or portions of the client communication for that client.</p> <p><u>Page 32, lines 28 to page 22, line 4</u> As an optional but preferred step in the method, the variable information is automatically inserted into the client communications. This step preferably involves generating the client communication according to the communication format, wherein the generating step includes inserting the subset of variable information into the variable portion of the client communication corresponding to the variable portion of the client communication format. The variable information preferably is inserted or merged into the format or other text of the client communication without unwanted gaps or spaces, so that the entire document appears to be created from a single source, or the entire document appears to be an integrated whole. The merged subset or subsets of the variable information may be formatted with the same font or a compatible font</p>	

Claims 1 & 64	Specification Support	Distinctions from De Lapa
least partially a customized identification, specification and/or promotion of said financial product or said financial service or both wherein said variable information for each specific entity has at least some data that is different. (e.g., col. 23, lines 46-49).	<p>to achieve this end.</p> <p><u>Page 33, lines 7-9</u> The generating step includes inserting the variable information or a subset of the variable information for a given client into the variable portion of the client communication for that client.</p> <p><u>Page 34, lines 4-19</u> The output module instead selectively can use substantial portions of client information, product information, and in many instances other information as well to generate a particularized communication tailored to the particular client for whom the communication is to be sent. The communications therefore typically will vary from individual client to individual client.</p> <p>Client communications generation according to the preferred embodiment and method involves organizing, formatting and outputting client communications using information received generally from the processor module. As explained, the processor module uses client information, information about available financial products, and perhaps other available information to recommend products, plans, and the like specifically tailored to each client. The output module allows the system user to define a particularized communication format for classes of customers, such as for potential individual mortgage insurance clients. It then</p>	

Claims 1 & 64	Specification Support	Distinctions from De Lapa
	<p>generates highly individualized communications specifically tailored to present that client with individualized plan and product presentations, reminders, followup, etc.</p> <p><i>Page 37, lines 28-30</i> This section may include text logic and product logic, for example, in that it may provide alternative descriptions, explanations, even different tone of writing depending on such things as the age of the client.</p>	
Claim 64		
<p><u>An apparatus of A system for automatically preparing communication data offering one or more financial products or financial services or both, comprising a processor and one or more associated databases:</u></p>		
<p>first determining means <u>within the processor</u> for automatically determining whether to offer a financial product or a financial service or both to a specific entity based on consideration of client data</p>	<p><i>Fig. 8</i></p>	

Claims 1 & 64	Specification Support	Distinctions from De Lapa
<p>on specific entities, (e.g., Fig. 8 and col. 18, lines 32-49 of related issued patent – application text indicated in the adjacent column)</p>	<p style="text-align: center;">PROCESSOR MODULE <i>Fig. 8</i></p> <pre> graph TD A[A: RUNS JOBS IN ORDER OF PRIORITY SCHEDULE BY PRODUCTION AND SCHEDULING MODULE] --> B[B: RETRIEVES DECISION INFORMATION AND OTHER INSTRUCTIONS ON WHAT TO DO AND HOW FOR EACH USER, PROGRAM, AND CLIENT.] B --> C[C: RETRIEVES NEXT CLIENT RECORD FROM CLIENT DATABASE.] C --> D1[D1: IDENTIFIES INSURANCE NEED.] D1 --> D2[D2: ANALYZES AND EVALUATES CLIENT DATA, INCLUDING DEMOGRAPHIC INFORMATION.] D2 --> D3[D3: DECIDES ON NUMBER AND TYPES OF PLAN(S) TO OFFER CLIENT, BASED ON D1 AND D2 ABOVE.] D3 --> D4[D4: SELECTS PRODUCT(S) TO FIT EACH PLAN OFFERED, BASED ON D1, D2, AND D3 ABOVE (UNLIMITED NUMBER OF POLICIES OR CARRIERS CAN BE USED)] D4 --> D5[D5: DECIDES ON EXACT AMOUNT(S) OF COVERAGE TO OFFER FOR EACH PLAN, BASED ON D1, D2, D3, AND D4 ABOVE.] D5 --> End[] Perf[ANALYZES PAST OR CURRENT PERFORMANCE OF SALES PROGRAM(S)] --> D3 Perf --> D4 </pre> <p><i>Page 26, line 29 to page 27, line 7</i></p> <p>In step D3 of the processor module flow depicted in FIG. 8, the module decides on the number and types of plans to be proposed to the client, which represents financial product variable information. This decision is based upon the insurance needs of the clients as identified in the decision information, on the client information in the client record, and possibly on other information such as demographic information, geo-coding information, etc. This step involves making an informed intelligent decision regarding the</p>	

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	<p>possible solution or solutions to the product or protection needs of the customer. Factors which may be considered by the module in this selection process may include the client demographic information (e.g. age, gender, tobacco usage, and occupation) mortgage information, financial information such as income, marital information, existing policy information, family-related information, and other factors selected by the system user and incorporated into the processor module decision making criteria.</p> <p>means <u>Page 25, lines 8-14</u> The processor module flow at block C retrieves the information, in this case a client record (client information), which is to be used with the decision information in selecting the variable information. By operating upon the decision information, such as database query commands based upon the client database fields, the system processes the client information and uses it to select the variable information. The type of information retrieved by the processor module will depend upon the type of analysis under consideration, and for which the system has been adapted.</p>	
<p>second determining means <u>within</u> <u>the processor</u> for <u>using</u></p>	<p><u>Page 24, lines 8-12</u> According to the method, the decision information is used or processed to automatically select variable information. In the</p>	

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<p><u>client specific decision information for automatically determining parts of data from at least two different databases comprising client data and financial product data to assemble variable information</u> if it is determined to offer said financial product or said financial service or both to said specific entity, (<i>e.g., col. 16, lines 44-50 and col. 18, lines 26-31 of related issued patent – application text indicated in the adjacent column</i>) <u>the second determining means selecting the variable information for inclusion in the communication data</u> formulated to express the offering for said specific entity (<i>e.g., col. 16, lines 55-58 and col. 22, lines 11-14 of related issued patent – application text indicated in the adjacent column</i>); and</p>	<p>preferred method, the decision information is used to select a subset of the variable information for inclusion in the variable portion or portions of the client communication corresponding to the variable portion or portions of the client communication format.</p> <p><i>Page 24, lines 16-18</i> The subset of variable information for a given client then may be used in the subsequently-prepared communication for that client to individualize or personalize the communication.</p> <p><i>Page 25, lines 8-12</i> The processor module flow at block C retrieves the information, in this case a client record (client information), which is to be used with the decision information in selecting the variable information. By operating upon the decision information, such as database query commands based upon the client database fields, the system processes the client information and uses it to select the variable information.</p> <p><i>Page 26, lines 25-28</i> Variable information may be selected using client information, <i>i.e.</i>, the decision information may include using client information to select the variable information for inclusion in the client communication. This is generally true regardless of the nature or content of the information actually selected as the variable information.</p>	

Claims 1 & 64	Specification Support	Distinctions from De Lapa
	<p><u>Page 27, lines 8-10</u> The processor module in conjunction with the decision information selects the variable information, in this example the financial products, which satisfy the decision making criteria being employed in the module.</p> <p><u>Page 32, lines 10-12</u> The subset or subsets of the variable information selected for a given client is adapted to be inserted into or provided as an integral part of the corresponding variable portion or portions of the client communication for that client.</p> <p>means <u>Page 26, lines 29-31</u> In step D3 of the processor module flow depicted in FIG. 8, the module decides on the number and types of plans to be proposed to the client, which represents financial product variable information.</p>	
<p>means for automatically generating <u>and creating</u> including at least one data processing device the communication data for said specific entity if it is determined to offer said financial product or said financial service or both to said specific entity, including</p>	<p><u>Page 32, lines 10-12</u> The subset or subsets of the variable information selected for a given client is adapted to be inserted into or provided as an integral part of the corresponding variable portion or portions of the client communication for that client.</p> <p><u>Page 32, lines 28 to page 22, line 4</u> As an optional but preferred step in the method, the variable information is automatically inserted into the client communications. This step</p>	

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<p><u>at least one data processing device associated with the processor and, the</u> communication data including at least one portion within the communication data that accommodates the variable information; (e.g., col. 22, lines 36-50 of related issued patent – application text indicated in the adjacent column) includes <u>including</u> at least partially a identification, specification and/or promotion for said entity, and wherein said variable information for each specific entity has at least some data that is different. (e.g., col. 23, lines 46-49 of related issued patent – application text indicated in the adjacent column).</p>	<p>preferably involves generating the client communication according to the communication format, wherein the generating step includes inserting the subset of variable information into the variable portion of the client communication corresponding to the variable portion of the client communication format. The variable information preferably is inserted or merged into the format or other text of the client communication without unwanted gaps or spaces, so that the entire document appears to be created from a single source, or the entire document appears to be an integrated whole. The merged subset or subsets of the variable information may be formatted with the same font or a compatible font to achieve this end.</p> <p><u>Page 33, lines 7-9</u> The generating step includes inserting the variable information or a subset of the variable information for a given client into the variable portion of the client communication for that client.</p> <p><u>Page 34, lines 4-19</u> The output module instead selectively can use substantial portions of client information, product information, and in many instances other information as well to generate a particularized communication tailored to the particular client for whom the communication is to be sent. The communications therefore typically will vary from individual client to individual client.</p>	

Claims 1 & 64	Specification Support	Distinctions from De Lapa
	<p>Client communications generation according to the preferred embodiment and method involves organizing, formatting and outputting client communications using information received generally from the processor module. As explained, the processor module uses client information, information about available financial products, and perhaps other available information to recommend products, plans, and the like specifically tailored to each client. The output module allows the system user to define a particularized communication format for classes of customers, such as for potential individual mortgage insurance clients. It then generates highly individualized communications specifically tailored to present that client with individualized plan and product presentations, reminders, followup, etc.</p> <p>means</p> <p><u>Page 12, line 27 to page 13, line 10</u></p> <p>The system includes a high-quality laser printer 32, such as any of the high-end commercially-available laser printers available for processors of the type employed in this system. Large-volume commercial laser printers also may be used for producing large quantities of client communications at rapid rates. The system also may include as an output a modem such as modem 20 or similar on-line or networked connection.</p>	

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	<p>Processor 12 has resident within its accessible memory system computer software or system software, a flow diagram of which is shown in FIG. 2. The software has a "core" system for processing tasks such as selecting variable information and preparing client communications. The system software also includes an "administrative and support" system for supporting the core system, facilitating the communication or marketing program, providing administrative and management reports and functions, and other tasks. The core system includes a plurality of modules, including a data input module, a database module, a processor module, and a sales presentation and output module. The administrative and support system includes a production and scheduling module, a sales and financial report and analysis module, a telemarketing module, a communications interface module, and an automated new business processing module. Each of these systems and modules will be described in greater detail below.</p> <p><u>Page 34, lines 20-26</u></p> <p>The output module is adapted to present its output in a variety of forms. For example, the output can be displayed on display 14 for visual inspection by the system user, or client, etc. The output also may be in the form of a printed communication or document using a printer such as a laser printer. It</p>	

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	may be in the form of an automated document or data file or both, and it also may be in a form suitable for transmission, for example, over modem 20 or to a network, with or without simultaneous video conferencing.	

Reasons by Which De Lapa is Distinct

- De Lapa does not teach automatically composing or creating (without human intervention) an offering of a financial product or service, it teaches a mechanism that offers a “discount” on the price of some tangible products**

The claims at issue here are directed to an invention that is completely different from De Lapa. De Lapa is directed to “coupons,” which serve as a “discount” on the price of a tangible product when a purchase is made (see column 3, lines 15-18, column 4, lines 39-42, and column 6, lines 43-48 in De Lapa, and the text copied below). That “discount” cannot be characterized as a financial product itself (see column 4, lines 37-39 and column 6, lines 43-48 in De Lapa and the text copied below). Nor can that “discount” be characterized as an offering of a financial product or service. At best, it is an offering of a reduction on the price of a product to which the coupon applies.

De Lapa, column 3, lines 15-18

The coupon identification will specify at least the discount value of the coupon and may additionally include a transaction to which the discount value is to apply.

De Lapa, column 4, lines 39-42

Such discounts are typically provided by the manufacturer in terms of a total discount which may be distributed among a number of coupons or a given discount per coupon.

De Lapa, column 6, lines 43-48

It is not necessary that coupon 48 pertain only to a particular product. Alternatively, it could apply to a purchase from the participating retailer above a set amount, as indicated at 50' or

apply to purchases at a particular department, such as the delicatessen department, of the retailer (not shown).

De Lapa, column 4, lines 37-39

The system may distribute coupons, whose value have been provided by various manufacturers, in order to promote the products of that manufacturer.

On page 5 of the office action, the Examiner responds to this reasoning, stating that

“regardless if Delapa teaches issuing a coupon for the product being offered, it still meets the claimed invention of offering or suggesting a specific product to an entity based on the coupon issued to the customer. DeLapa offer of the product includes the extra step of issuing a coupon for the product but nevertheless, the coupon is for a specific product that meets the entity or customer’s criteria. In Delapa the product is not a financial product but the Examiner has taken Official of replacing DeLapa products with financial services is obvious.

Applicant respectfully submits that even if De Lapa suggests an offering based on the coupon issued to the customer it does **not** teach automatically determining without human intervention, variable information specific to each specific entity and composing the variable information in a communication to create an offering for each specific entity

In addition, although “in DeLapa the product is not a financial product the Examiner has taken official notice of replacing DeLapa grocery products with financial services is obvious.” To that end, Applicant submits that the courts and the PTO have recognized further limitations on the use of Official Notice. In response to more recent court decisions, the PTO revised the Manual of Patent Examining Procedure (MPEP) to severely restrict the circumstances in which Official Notice of facts may be maintained. For example, MPEP 2144.03 summarizes those cases and states “If applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence (support under 37 C.F.R. 1.104(d)) in the next Office action if the rejection is to be maintained.” In the present case, the documentary evidence is lacking and therefore the rejection should not be maintained.

Whereas the Official Notice asserts that the grocery products and financial products are interchangeable, Applicant submits that De Lapa’s coupons are not the grocery product itself but

a discount to be exercised upon purchase. Accordingly, the Applicant asks the Examiner to withdraw the Official Notice at this time.

2. **De Lapa does not teach automatically determining (without human intervention) variable information specific to the entity for whom the product offering is created**

In De Lapa, the “variable” information on the “coupon” is specific to the entity only to the extent of indicating the identity of the entity (see column 9, line 67-column 10, line 4 and Figure 2 in De Lapa and the text copied below).

De Lapa, column 9, line 67-column 10, line 4

The master data base will capture for each coupon 48 used by the consumer, data identifying the coupon I.D., namely product identification, coupon value, expiration date, as well as the identification code, or household code of the consumer.

Other than that, any information that is variable pertains to the discount, such as the degree or extent of “discount” offered by a manufacturer on the pricing of a product or the expiration date of the discount offering, etc. (see column 16, lines 32-36, 52-62 and Figure 2 in De Lapa and the text copied below).

De Lapa, column 16, lines 32-36, 52-62

The system identifier establishes whether the bar code is for (A) a standard product of the type sold by established manufacturers, (B) a standard coupon of the type typically issued by manufactures of products, or (C) an in-store custom application.

Once the record is retrieved for a scanned code, the master terminal tallies the price to the purchase total, if the code is for a product being purchased. If the code is for a coupon, the master terminal will give a credit against the purchase. The master terminal may optionally verify that a product corresponding to that of the coupon has been purchased as a condition to giving a credit against the purchase. Typically, a transaction record is generated and uploaded to the store management computer in order to adjust the inventory records for the product and for statistical analysis and the like.

None of these parameters are “variable” information specific to the entity for whom a financial product or service is being created as claimed in Applicant’s method and system. The Examiner’s attention is pointed to the following text in De Lapa, by way of an example of this distinction (see column 3, lines 13-19 in De Lapa and text copied below):

De Lapa, column 3, lines 13-19

The coupons thus generated will be variable as to at least the identity of the consumer and a coupon identification, both of which are encoded on the coupon in machine readable form. The coupon identification will specify at least the discount value of the coupon and may additionally include a transaction to which the discount value is to apply.

On page 6 of the office action, the Examiner disagrees with the Applicant’s reasoning, pointing to column 5, lines 11-17, of De Lapa. The Examiner states that De Lapa teaches “variable information specific to the entity,” “by assigning higher coupon values to non-customer of the participating retailer establishment than to regular established customers.” While the coupons may have the appearance of variability, Applicant notes that the assignment of pre-defined coupons, as is performed in De Lapa, is distinct from automatically determining variable information and creating an offering, as claimed in the instant application. Considering all that De Lapa teaches, the meaning of the phrase “assigning higher coupon values” is really “assigning higher-valued coupons” to non-customers.

De Lapa **does not**, and according to the disclosed database structures, **cannot** determine variable information to vary in a particular coupon offer¹. It merely selects a pre-existing coupon from 1-5 choices for a given product that is pre-defined by its database structures. In De Lapa, the ‘Current Coupon Table’ (Table 6) and the ‘Coupon Master Structure Table (Table 5) define any available coupon at any time. Coupon Master Structure fields define everything for a coupon except for the coupon’s value, start and end dates, and expiration dates. The Current Coupon table is subordinate to the Coupon Master Structure table. In other words, the Current

¹ Only optional coupons will be discussed here. As disclosed in De Lapa, mandatory and default coupons do not vary from consumer to consumer. See column 13, lns. 62-65. Any assignment results in the same coupon to all customers chosen for a particular cycle of mailing. See column 6, lns. 7-19 and column 13, lns. 62- column 14, l2. Thus, the only coupons that can be alleged to contain “variable information” are the “optional” coupons.

Coupon table defines the discrete and static instances of a coupon available for a particular mailing. Note the notation next to the field "COUPON-AMOUNT" (occurs 5 times). column 13, ln.8. This clearly means that only 5 instances of a coupon value pre-exist and must be pre-defined for any given product offer.

For example, to have two coupons for soup with 2 different coupon amounts (e.g., 5 cents off and 10 cents off), there must be two records created in the Current Coupon database (one for a 5 cent coupon and one for a 10 cent coupon). This reveals that the coupon amount, i.e., discount, is not variable but must pre-exist, i.e. be "hard-coded" or "pre-defined", in the system to be available to assign. Also, note that the selection process in De Lapa has not yet been executed at all during the creation of these coupons. De Lapa's method requires human intervention to enter the coupons into the database, which is the point of creation of the coupon offers. These tables are not used by De Lapa's method to **determine, compose or create** any variable information. Rather, the De Lapa method is used to create a data file for printing. column 12, lns.58-61.

At the time of assignment (of an optional coupon) and following the soup example above, there are two and only two distinct and separate coupons available to assign to any given consumer. De Lapa will select a consumer, and automatically determine if a **coupon** should be **assigned**. See column 15, lns. 1-30. De Lapa makes this "optional coupon" assignment by looking at a Coupon/Answer Relations table (Table 7). This table relates **coupons to responses regardless of the consumer who answered the survey**. See column 13, lns. 30-35. In other words, it assigns a particular coupon (not just the amount, but the whole coupon, as all information within this particular coupon has been pre-determined), to responses on a survey **only**. In essence, these coupons are all assigned prior to any process involving specific customers, or before executing De Lapa's selection process. Thus, once a coupon selection process is started, everything about the coupon expressing any offering is static (i.e., not variable).

Moreover, De Lapa's method does not use decision information to determine any variable information for any given coupon (i.e., any information at the field level); again, the coupons at this point pre-exist, and are pre-defined by human intervention through entering the values in the database before De Lapa's method is executed. De Lapa's method uses decision

information to assign the pre-defined coupons to be printed for a particular consumer. De Lapa's method cannot create or compose an offering with variable information because such information is simply not available in De Lapa.

Furthermore, Fig. 2 of De Lapa reveals the coupons are only variable to the extent that each offer presented has a distinct and separate record in the database. Therefore, the product discounts may vary, however, the communications that express the product offers do not and cannot vary. Everyone receiving a soup discount coupon for 5 cents off will have the exact same coupon per selection process. Everyone receiving a soup discount coupon for 10 cents off will receive the exact same coupon. Thus, the De Lapa selection process does not assign different coupon values to different types of customers, but assigns different coupons to different types of customers. The values are not variable but are static and are determined by humans before De Lapa's method is executed and any customer is considered. As such, De Lapa's method is distinct from the claimed system, which automatically (without human intervention) determines variable information and then automatically creates an offering for the specific entity.

3. De Lapa does not teach creating a financial product or service or both using the identity of the entity

In De Lapa, the identity of the person, to the extent it is utilized, is only for the purpose of either (1) delivering coupons to offer a "discount" to a particular consumer or (2) matching records to determine when the coupon delivered to the consumer have been redeemed (see column 3 lines 23-30 and column 18 lines 13-16). The actual identity of the person receiving and redeeming the coupon (i.e., purchasing the product) is never verified (see column 18 lines 13-16).

De Lapa, column 3 lines 23-30

A method according to another aspect of the invention includes identifying a particular consumer, printing a packet of coupons for the identified consumer, transmitting the packet to the consumer, identifying which coupons in the packet the consumer uses and printing another packet of coupons for that consumer, with at least one coupon selected as a function of the coupons the consumer used. Other consumption related information pertaining to the

consumer may be combined with the history of coupon use in order to select coupons to transmit to the consumer.

De Lapa, column 18 lines 13-16

When that one record is retrieved, the in-store master terminal can credit the purchaser of the product, keep appropriate transaction records and the like. The in-store system 69 does not become apprised of the coupon program member corresponding to the scanned code bearing their household I.D.

The identity is not used for the purpose of creating a financial product or service specific to the entity for whom it is intended (see e.g., column 6, lines 31-34 and column 18, lines 13-16). De Lapa's coupon offers a discount toward a future purchase of a tangible product (identified in machine readable code).

De Lapa, column 6, lines 31-34

As will be set forth in more detail below, machine readable code 56 is encoded to allow access to the identity of the product or purchase criterion, the expiration date of the coupon and the discount amount.

On page 6, paragraph 6 of the office action, the Examiner points out that customers' criteria are used to determine which products to offer. For example, if a customer has children, then coupons are created pertaining to children's products. However, Applicant respectfully submits that the coupons are not related to customer criteria, but survey answers. The customer is irrelevant. In fact, De Lapa's method requires the customer to perform any selection or assignment process, which occurs at the time the customer completes the survey and not using De Lapa's method. De Lapa merely automates the **customer's** selection process. It is in this light, Applicant respectfully submits that the coupons are not automatically created by DeLapa's method and that they pre-exist as pre-defined (by human intervention) product discount offers. As such, De Lapa cannot teach the automatic determination of variable information and creating offerings as claimed.

Conclusion

Accordingly, Applicant submits that claims 1, 64, 159, 182 and 197, as amended above, emphasize these distinctions and clearly distinguish over De Lapa as well as other references of

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record. Under separate cover, Applicant is submitting an information disclosure statement citing additional references that have come to Applicant's attention.

Reconsideration and allowance of these claims is most earnestly solicited. The remaining claims depend from the independent claims and are distinct at least for the reasons by which the independent claims are distinct. Moreover, other reasons that distinguish these claims are indicated in the prior responses, the content of which is incorporated herein by reference. The undersigned requests the Examiner to call her to resolve outstanding issues in order to expedite consideration and allowance of this application.

Respectfully submitted,

BERRY & ASSOCIATES P.C.

Dated: May 5, 2008

By: 

Reena Kuyper

Registration No. 33,830

9255 Sunset Blvd., Suite 810
Los Angeles, CA 90069
(310) 247-2860